

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	\$ Group Art Unit: 3621
Calderaro, et. al.	\$ Confirmation No.: 1316
	\$ Examiner: Le, Nancy Loan T.
Serial No.: 10/042,414	\$
	\$ Attorney Docket No.
Filed: January 8, 2002	\$ AUS920010786US1
	\$
Title: <u>System and Method for</u>	\$ IBM Corporation
<u>Resource Reduction Receipt</u>	\$ Intellectual Property Law
<u>Log and Audit Trail</u>	\$ Dept.
	\$ 11400 Burnet Road
	\$ Austin, Texas 78758

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

### Certificate of Mailing or Transmission

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 or electronically transmitted to the U.S. Patent and Trademark Office on the date shown below.

/Leslie A. Van Leeuwen Reg. No. 42,196/ May 22, 2006  
Leslie A Van Leeuwen Reg. No. 42,196 Date

**APPELLANTS' BRIEF (37 CFR § 41.37)**

Sir:

## A. INTRODUCTORY COMMENTS

This brief is filed in support of the previously filed Notice of Appeal, filed in this case on March 30, 2006, which appealed from the decision of the Examiner dated December 30, 2005, finally rejecting claims 1, 2, 4-6, 8, 9, 11-15, and 17-19. Please charge the required fee under 37 CFR § 41.20(b)(2) to IBM Corporation Deposit Account No. 09-0447.

The two-month deadline for filing this Appeal Brief is May 30, 2006, therefore, no extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and the undersigned hereby authorizes the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

**B. REAL PARTY IN INTEREST**

The real party in interest in this appeal is International Business Machines Corporation, which is the assignee of the entire right, title, and interest in the above-identified patent application.

**C. RELATED APPEALS AND INTERFERENCES**

With respect to other prior or pending appeals, interferences, or judicial proceedings that are related to, will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such prior or pending appeals, interferences, or judicial proceeding known to Appellants, Appellants' legal representative, or assignee.

**D. STATUS OF CLAIMS***1. Total number of claims in application*

There are 15 claims pending. Three claims are independent claims (1, 8, and 14), and the remaining claims are dependent claims.

*2. Status of all claims in application*

- Claims canceled: 3, 7, 10, 16, and 20
- Claims withdrawn from consideration but not canceled: none
- Claims pending: 1, 2, 4-6, 8, 9, 11-15, and 17-19
- Claims allowed: None
- Claims rejected: 1, 2, 4-6, 8, 9, 11-15, and 17-19

*3. Claims on appeal*

The claims on appeal are: 1, 2, 4-6, 8, 9, 11-15, and 17-19.

**E. STATUS OF AMENDMENTS**

All amendments have been entered in this case. No amendments have been made to the claims after the Final Office Action.

**F. SUMMARY OF CLAIMED SUBJECT MATTER**

Appellants provide a concise summary of the claimed subject matter as follows. Claims 1, 8, and 14 are independent claims. Note that claims 1, 2, and 4-6 are method claims, claims 8, 9, and 11-13 are information handling system claims, and claims 14, 15, and 17-19 are computer program product claims. Independent claims 8 and 14 include means plus function limitations that correspond to the method steps set forth in independent claim 1. An information handling system capable of implementing Appellants' invention, as claimed in independent claim 8, is shown in Figure 40, and described in Appellants' specification on page 96, line 6 through page 97, line 19. Support for independent computer program product claim 14 is described in Appellants' specification on page 97, line 20 through page 98, line 9. In addition, support for each of the method steps and means plus function limitations of the independent claims are discussed below (using independent claim 1 as an exemplary claim). The specific citations to Appellants' Figures and Specification are meant to be exemplary in nature, and do not limit the scope of the claims. In particular, the citations below do not limit the scope of equivalents as provided under 35 U.S.C. § 112, sixth paragraph.

Support for each of the elements of the independent claims (i.e. independent claims 1, 8, and 14) is described using independent claim 1 as an exemplary claim. The claimed invention is a method, information handling system, and computer program product for tracking surplus reduction actions, including the elements of receiving a surplus reduction action from a user, wherein the user is an employee and wherein the surplus reduction action includes a surplus acknowledgement (see e.g., Figure 38, reference numerals 3835 and 3840, page 92, line 27 through page 95, line 2; also see Figure 39, reference numeral 3964, page 95, line 3 through page 96, line 5); identifying a user identifier corresponding to the user (see e.g., Figure 37, reference numeral 3704, page 90, line 6 through page 92, line 26; also see Figure 38, reference numerals 3870 and 3885, page 92, line 27 through page 95, line 2); storing the user identifier and data corresponding to the surplus reduction action in a non-volatile storage area (see e.g., Figure 38,

reference numeral 3845, page 92, line 27 through page 95, line 2); and providing benefits data to the employee in response to receiving the employees' surplus acknowledgement (see e.g., Figure 38, reference numeral 3850, page 92, line 27 through page 95, line 2).

Support for each of Appellants' means plus function limitations set forth in dependent claims that are argued separately is provided below. Note that general support for an information handling system and computer program product is discussed above. The specific citations to Appellant's Figures and Specification are meant to be exemplary in nature, and do not limit the scope of the claims, as provided under 35 U.S.C. § 112, sixth paragraph.

Claims 11 and 17 are argued separately below, as part of a group of claims including claims 4, 11, and 17. Claims 11 and 17 include the following means plus function limitations:

- means for sending the employee a non-compete agreement (see e.g., Figure 38, reference numerals 3820 and 3825, page 92, line 27 through page 95, line 2);

- means for receiving a digital signature from the employee corresponding to the non-compete agreement (see e.g., Figure 38, reference numeral 3840, page 92, line 27 through page 95, line 2; also see Figure 39, reference numeral 3964, page 95, line 3 through page 96, line 5); and

- means for storing the employee's digital signature in the nonvolatile storage area (see e.g., Figure 38, reference numeral 3845, page 92, line 27 through page 95, line 2).

Claims 12 and 18 are argued separately below, as part of a group of claims including claims 5, 6, 12, 13, 18, and 19. Claims 12 and 18 include the following means plus function limitations:

- means for identifying one or more surplus employees that have confidential knowledge of an organization (see e.g., Figure 37, reference numerals 3708 and 3712, page 90, line 6 through page 92, line 26); and

- means for writing a non-compete indicator to a non-compete data storage area corresponding to the identified surplus employees, wherein the non-compete agreement is sent to surplus employees in response to the identification (see e.g., Figure 37, reference numerals 3716 and 3720, page 90, line 6 through page 92, line 26; also see Figure 38, reference numerals 3820 and 3822, page 92, line 27 through page 95, line 2).

**G. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 1, 2, 4-6, 8, 9, 11-15, and 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wheeler et al., U.S. Patent Publication No. 2003/0177361 (hereinafter Wheeler).

**H. ARGUMENTS – APPELLANTS' CLAIMS ARE NOT OBVIOUS, AND ARE THEREFORE PATENTABLE, OVER THE ART OF RECORD****1. Claims 1, 2, 8, 9, 14, And 15 Are Not Obvious And Are Therefore Patentable Over Wheeler**

Appellants respectfully submit that Wheeler does not teach or suggest all the elements of Appellants' claims. Appellants teach and claim a method, system, and computer program product for tracking and logging receipts and maintaining an audit trail during a resource reduction. In contrast, Wheeler purports to teach a method for digitally signing an electronic contract (see Wheeler, Abstract). Wheeler does not appear to have anything to do with a resource reduction. With regard to Appellants' independent claims, the Examiner cites several portions of Wheeler, including paragraphs 103, 104, and 106. However, the cited portions of Wheeler have to do with using public and private keys to securely manage an electronic purchase order. Using claim 1 as an exemplary claim, Appellants respectfully submit that Wheeler does not teach or suggest any of the elements of Appellants' independent claims, listed below as follows (emphasis added):

- receiving a *surplus reduction action* from a user, wherein *the user is an employee* and wherein *the surplus reduction action includes a surplus acknowledgment*;
- identifying a *user identifier* corresponding to the user;
- *storing the user identifier and data corresponding to the surplus reduction action* in a nonvolatile storage area; and
- *providing benefits data* to the employee *in response to receiving the employee's surplus acknowledgement*

Although Wheeler does not teach or suggest any of Appellants' claimed elements, the Examiner asserts that Appellants' claim elements are not relevant as they are merely "non-functional descriptive material." Appellants strongly disagree and respectfully submit that the Examiner is not using the correct definition of non-functional descriptive material.

The section of the Manual of Patent Examining Procedure that discusses non-functional descriptive material reads as follows (MPEP § 2106(IV)(B)(1)(b), emphasis added):

Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. Thus, Office personnel should consider **the claimed invention as a whole** to determine whether the necessary functional interrelationship is provided.

Where certain types of descriptive material, such as music, literature, art, photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship, either as part of the stored data or as part of the computing processes performed by the computer, then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer. Such "descriptive material" is not a process, machine, manufacture or composition of matter. (Data consists of facts, which become information when they are seen in context and convey meaning to people. Computers process data without any understanding of what that data represents. Computer Dictionary 210 (Microsoft Press, 2d ed. 1994).)

The policy that precludes the patenting of nonfunctional descriptive material would be easily frustrated if the same descriptive material could be patented when claimed as an article of manufacture. For example, music is commonly sold to consumers in the format of a compact disc. In such cases, the known compact disc acts as nothing more than a carrier for nonfunctional descriptive material. The purely nonfunctional descriptive material cannot alone provide the practical application for the manufacture.

**Office personnel should be prudent in applying the foregoing guidance. Nonfunctional descriptive material may be claimed in combination with other functional descriptive multi-media material on a computer-readable medium to provide the necessary functional and structural interrelationship to satisfy the requirements of 35 U.S.C. 101.** The presence of the claimed nonfunctional descriptive material is not necessarily determinative of nonstatutory subject matter. For example, a computer that recognizes a particular grouping of musical notes read from memory and upon recognizing that particular sequence, causes another defined series of notes to be played, defines a functional

interrelationship among that data and the computing processes performed when utilizing that data, and as such is statutory because it implements a statutory process.

Appellants' "claimed invention as a whole" is clearly statutory under 35 U.S.C. § 101. Rejections based on non-statutory descriptive material are typically used to prevent claims for music, literary works, etc. Material that is not patentable, such as a song, can not become patentable merely because it is stored, for example, on a compact disk. However, once a claim is deemed to be statutory, the Examiner can not ignore elements of the claim by asserting that they are "non-functional descriptive material." This is shown by the example given in the MPEP section cited above. Although a sequence of notes is not patentable on its own, a computer program that recognizes a sequence of notes and then causes another sequence of notes to be played, is patentable. Assuming, as an example and solely for the sake of argument, that the "surplus reduction action" or the "benefits data" claimed by Appellants would not be patentable on their own, once they become integral parts of a statutory claim, they can not be ignored.

According to the Manual of Patent Examining Procedure § 2143.03 (emphasis added), "[t]o establish *prima facie* obviousness of a claimed invention, ***all the claim limitations*** must be taught or suggested by the prior art," (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). This section further provides that "***[a]ll words in a claim must be considered*** in judging the patentability of that claim against the prior art," (citing *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). Appellants assert that all the claim limitations, including the limitations pertaining to a "surplus reduction action," an "employee," a "surplus acknowledgement," a "user identifier," and "benefits data" must be considered when determining whether the claims are non-obvious in view of the prior art.

Furthermore, Appellants firmly believe that the surplus reduction action, the employee, the surplus acknowledgement, the user identifier, and the benefits data claimed by Appellants are ***not*** non-functional descriptive material, but rather are a necessary part of the functional and structural relationship claimed in independent claims 1, 8, and 14. As claimed, the surplus reduction action describes exactly what is received from a user. The user is an employee, and the surplus reduction action includes a surplus acknowledgement. Each user has a user identifier, which is stored along with data corresponding to the surplus reduction action.

Benefits data is then provided to the employee. These elements are an integral part of Appellants' claims, and define the metes and bounds of Appellants' claimed invention.

In particular, Appellants note that benefits data is provided to the employee "*in response to* receiving the employee's surplus acknowledgement." In other words, an employee only receives benefits data after his surplus acknowledgement has been received. This clearly shows the interrelationship of the content of the surplus acknowledgement and the function (i.e. the provision of benefits data) as taught and claimed by Appellants. The surplus acknowledgement must be received before the benefits data is provided. Nothing in Wheeler teaches or suggests any type of interrelationship between a surplus acknowledgement and benefits data, as taught and claimed by Appellants in independent claims 1, 8, and 14.

The prior art simply does not teach or suggest the elements claimed by Appellants in independent claims 1, 8, and 14. The purchase order disclosed in Wheeler is not analogous to the surplus reduction action or the surplus acknowledgement that is taught and claimed by Appellants. Providing an invoice in response to receiving a purchase order is not analogous to providing benefits data to an employee. Wheeler has absolutely nothing to do with tracking surplus reduction actions, as taught and claimed by Appellants, and therefore, can not be used to support an obviousness rejection of Appellants' claimed invention.

For the reasons set forth above, Appellants respectfully submit that independent claims 1, 8, and 14, and the claims which depend from them, are patentable over Wheeler, and respectfully request that they be allowed.

## **2. Claims 4, 11, And 17 Are Not Obvious And Are Therefore Patentable Over Wheeler**

Claims 4, 11, and 17 depend from independent claims 1, 8, and 14, respectively, and are therefore patentable for at least the reasons discussed above with regard to the independent claims. In addition, using claim 4 as an exemplary claim, claims 4, 11, and 17 include the following elements:

- sending the employee a non-compete agreement;
- receiving a digital signature from the employee corresponding to the non-compete agreement; and
- storing the employee's digital signature in the nonvolatile storage area.



A close reading of Wheeler does not reveal any teaching or suggestion of sending a non-compete agreement to an employee. In the Office Action mailed July 17, 2005, the Examiner asserts that a purchase order is analogous to a surplus acknowledgement (see page 2, lines 1-3). The Examiner then further asserts that this same purchase order is also analogous to a non-compete agreement (see page 3, lines 13-16). Appellants do not agree that a purchase order is analogous to either a surplus acknowledgement or a non-compete agreement. Further, Appellants do not understand how the Examiner can use the same cited purchase order to read on both a surplus acknowledgement received from an employee and a non-compete agreement sent to the employee.

Appellants further note that it would not necessarily make sense for Wheeler to send or receive non-compete agreements. Wheeler is dealing with transactions between merchants and suppliers, and these types of transactions do not typically have any need for non-compete agreements. Wheeler does not make the slightest mention of non-compete agreements, and therefore, does not teach or suggest “sending the employee a non-compete agreement,” or “receiving a digital signature from the employee corresponding to the non-compete agreement,” as taught and claimed by Appellants in claims 4, 11, and 17. Therefore, Appellants respectfully submit that claims 4, 11, and 17, and the claims which depend from them, are not obvious, and are therefore patentable over Wheeler.

**3. Claims 5, 6, 12, 13, 18, And 19 Are Not Obvious And Are Therefore Patentable Over Wheeler**

Claims 5, 12, and 18 depend from claims 4, 11, and 17, respectively, and are patentable for at least the reasons discussed above. In addition, using claim 5 as an exemplary claim, claims 5, 12, and 18 include the following elements:

- identifying one or more surplus employees that have confidential knowledge of an organization; and
- writing a non-compete indicator to a non-compete data storage area corresponding to the identified surplus employees, wherein the non-compete agreement is sent to surplus employees in response to the identification.

As discussed above with regard to claims 4, 11, and 17, Wheeler does not disclose a non-compete agreement, as taught and claimed by Appellants. Appellants further submit that Wheeler does not teach or suggest “identifying one or more surplus employees that have confidential knowledge of an organization.” In the Office Action mailed July 17, 2005, the Examiner cites Wheeler at paragraphs 104 and 106 as disclosing this aspect of Appellants’ claims. However, the cited sections of Wheeler discuss using an identifier to retrieve a purchasing agent’s public key, along with account information corresponding to the purchasing agent (see Wheeler, paragraph [0104]). The cited sections of Wheeler also note that the account information may contain business rules that may preclude shipping certain items to the purchasing agent (see Wheeler, paragraph [0106]). The cited sections of Wheeler do not disclose identifying a surplus employee that has *confidential knowledge of an organization*, as taught and claimed by Appellants. Further, Wheeler does not teach or suggest writing any type of indicator, much less a non-compete indicator, to a data storage area in response to such an identification. The mere fact that Wheeler identifies purchasing agents and may store or save information pertaining to these purchasing agents is simply not analogous to “identifying one or more surplus employees *that have confidential knowledge of an organization*,” and then “writing *a non-compete indicator* to a non-compete data storage area corresponding to the identified surplus employees *in response to the identification*,” as taught and claimed by Appellants. Once again, the Examiner appears to be ignoring key elements of Appellants’ claims.

For the reasons set forth above, Appellants respectfully submit that claims 5, 12, and 18, and the claims which depend from them, are patentable over Wheeler, and respectfully request that they be allowed.

**Conclusion**

For the foregoing reasons, Appellants submit that claims 1, 2, 4-6, 8, 9, 11-15, and 17-19 are allowable over Wheeler. Accordingly, Appellants respectfully request that the Examiner's claim rejections be reversed and claims 1, 2, 4-6, 8, 9, 11-15, and 17-19 be allowed.

Respectfully submitted,

By /Leslie A. Van Leeuwen Reg. No. 42,196/  
Leslie A. Van Leeuwen, Reg. No. 42,196  
Van Leeuwen & Van Leeuwen  
Attorneys for Appellants  
Telephone: (512) 301-6738  
Facsimile: (512) 301-6742

**I. APPENDIX OF CLAIMS**

1. A method of tracking surplus reduction actions, said method comprising:
  - receiving a surplus reduction action from a user, wherein the user is an employee and wherein the surplus reduction action includes a surplus acknowledgment;
  - identifying a user identifier corresponding to the user;
  - storing the user identifier and data corresponding to the surplus reduction action in a nonvolatile storage area; and
  - providing benefits data to the employee in response to receiving the employee's surplus acknowledgement.
2. The method as described in claim 1 further comprising:
  - receiving a digital signature from the user;
  - authenticating the digital signature; and
  - storing the digital signature in the nonvolatile storage area.
4. The method as described in claim 1 further comprising:
  - sending the employee a non-compete agreement;
  - receiving a digital signature from the employee corresponding to the non-compete agreement; and
  - storing the employee's digital signature in the nonvolatile storage area.
5. The method as described in claim 4 further comprising:
  - identifying one or more surplus employees that have confidential knowledge of an organization; and
  - writing a non-compete indicator to a non-compete data storage area corresponding to the identified surplus employees, wherein the non-compete agreement is sent to surplus employees in response to the identification.
6. The method as described in claim 5 further comprising:
  - selecting the group of identified surplus employees;

analyzing digital signatures received from one or more of the identified surplus employees;  
determining based on the analysis which of the identified surplus employees have not provided digital signatures in response to non-compete agreements; and  
sending a reminder notification to the determined group of surplus employees.

8. An information handling system comprising:
- one or more processors;
  - a memory accessible by the processors;
  - a nonvolatile storage area accessible by the processors;
  - a tracking tool for tracking surplus reduction actions, the tracking tool including:
    - means for receiving a surplus reduction action from a user, wherein the user is an employee and wherein the surplus reduction action includes a surplus acknowledgment;
    - means for identifying a user identifier corresponding to the user;
    - means for storing the user identifier and data corresponding to the surplus reduction action in the nonvolatile storage area; and
    - means for providing benefits data to the employee in response to receiving the employee's surplus acknowledgement.
9. The information handling system as described in claim 8 further comprising:
- means for receiving a digital signature from the user;
  - means for authenticating the digital signature; and
  - means for storing the digital signature in the nonvolatile storage area.
11. The information handling system as described in claim 9 further comprising:
- means for sending the employee a non-compete agreement;
  - means for receiving a digital signature from the employee corresponding to the non-compete agreement; and
  - means for storing the employee's digital signature in the nonvolatile storage area.
12. The information handling system as described in claim 11 further comprising:

means for identifying one or more surplus employees that have confidential knowledge of an organization; and

means for writing a non-compete indicator to a non-compete data storage area corresponding to the identified surplus employees, wherein the non-compete agreement is sent to surplus employees in response to the identification.

13. The information handling system as described in claim 12 further comprising:

means for selecting the group of identified surplus employees;

means for analyzing digital signatures received from one or more of the identified surplus employees;

means for determining based on the analysis which of the identified surplus employees have not provided digital signatures in response to non-compete agreements; and

means for sending a reminder notification to the determined group of surplus employees.

14. A computer program product stored in a computer operable media for tracking surplus reduction actions, said computer program product comprising:

means for receiving a surplus reduction action from a user, wherein the user is an employee and wherein the surplus reduction action includes a surplus acknowledgment;

means for identifying a user identifier corresponding to the user;

means for storing the user identifier and data corresponding to the surplus reduction action in the nonvolatile storage area; and

means for providing benefits data to the employee in response to receiving the employee's surplus acknowledgement.

15. The computer program product as described in claim 14 further comprising:

means for receiving a digital signature from the user;

means for authenticating the digital signature; and

means for storing the digital signature in the nonvolatile storage area.

17. The computer program product as described in claim 14 further comprising:

means for sending the employee a non-compete agreement;

means for receiving a digital signature from the employee corresponding to the non-compete agreement; and

means for storing the employee's digital signature in the nonvolatile storage area.

18. The computer program product as described in claim 17 further comprising:

means for identifying one or more surplus employees that have confidential knowledge of an organization; and

means for writing a non-compete indicator to a non-compete data storage area corresponding to the identified surplus employees, wherein the non-compete agreement is sent to surplus employees in response to the identification.

19. The computer program product as described in claim 18 further comprising:

means for selecting the group of identified surplus employees;

means for analyzing digital signatures received from one or more of the identified surplus employees;

means for determining based on the analysis which of the identified surplus employees have not provided digital signatures in response to non-compete agreements; and

means for sending a reminder notification to the determined group of surplus employees.

**J. EVIDENCE APPENDIX**

Not applicable.



**K. RELATED PROCEEDINGS APPENDIX**

Not applicable.